



05/23/05

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert HUNTER Docket No.: 375283-00102
Serial No.: 10/615,572 Group Art Unit: 2857
Filed: July 8, 2003 Examiner: Tsai, Carol S.W.
For: **METHOD AND APPARATUS FOR READING AND CONTROLLING UTILITY
CONSUMPTION**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST TO WITHDRAW AS ATTORNEYS
OF RECORD IN PATENT MATTER**

Dear Sirs:

This is a request for permission to withdraw as attorneys of record in this application under 37 C.F.R. § 1.36.

1. REASON FOR REQUEST

The attorneys of record request mandatory withdrawal under 37 C.F.R. § 10.40, and specifically under 37 C.F.R. § 10.40(b)(4), because the client has discharged the firm and its practitioners from representing the client before the Patent Office in the above referenced matter (see attached copy of fax from Applicant).

2. DUE NOTICE TO APPLICANT

The attorneys of record have given due notice of their withdrawal to the client pursuant to the aforementioned discharge. We enclose a copy of the letter transmitted to the client containing such notice along with this Request To Withdraw.

3. DELIVERY OF PAPERS TO THE CLIENT

We have delivered or are in the process of delivering to the client all the papers comprising this application and its prosecution.

4. STATUS OF APPLICATION AND NEXT ACTION

The above identified application is pending. An outstanding final office action was mailed on April 6, 2005, and the 3 month shortened statutory period for reply is set to expire on July 6, 2005. The 6 month statutory period for response expires on October 6, 2005.

5. CHANGE OF CORRESPONDENCE ADDRESS

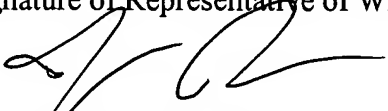
Please change the correspondence address and direct all future correspondence to:

Robert Hunter
TRENDPOINT SYSTEMS, INC.
111 Deerwood Road, Suite 200
San Ramon, CA 94583
Tel: 925.855.0600

6. REQUEST TO WITHDRAW MADE ON BEHALF OF ALL ATTORNEYS/AGENTS LISTED UNDER CUSTOMER NUMBER

This request to withdraw is made on behalf of me, all of the attorneys/agents of record, and all attorneys/agents listed under Customer No. 37509.


Signature of Representative of Withdrawing Attorneys:



Justin Boyce – Reg. No. 40,920

Signature of Representative of Withdrawing Attorneys on Behalf of All Withdrawing Attorneys

Dated: May 18, 2005


Justin Boyce
Reg. No. 40,920

Dechert LLP
P.O. Box 10004
Palo Alto, CA 9303-0961
T: 650.813.4800
F: 650.813.4848

CERTIFICATE OF MAILING (37 CFR 1.10(a))

CERTIFICATE OF MAILING BY "EXPRESS MAIL" - Rule 10: I hereby certify that this correspondence is being deposited on May 19, 2005 with the U.S. Postal Service "Express Mail Post Office to Addressee" under 37 CFR 1.10 as EL 989 611 116 US addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450

Date: May 19, 2005


Yvette Yturza-Owen

sent by: EXECUTIVE CASE NETWORK;
TRENDPOINT



May 18, 2005

Dechert LLP
1117 California Avenue
Palo Alto, CA 94304
Attn: Michael H. Kalkstein, Managing Partner

Re: TrendPoint Systems representation

Dear Mr. Kalkstein:

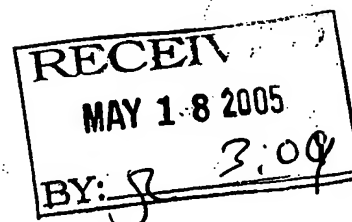
Thank you for the time to discuss our situation. As discussed, it has been determined to be in the best interest of TrendPoint that Dechert, LLP no longer serve as its IP council. This change is effective immediately.

Please have all files transferred to the undersigned immediately to allow us to move forward with our patent work. Please include with the files, all forms (signed) that will be necessary transfer the cases with the PTO. It is imperative that this material arrive in its entirety no later than one week from today, May 25, 2005.

Sincerely,

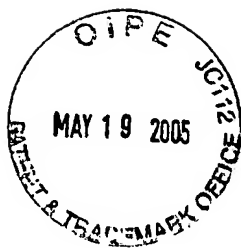

Robert E. Hunter

Manager, Member
TrendPoint Systems, LLC



111 Deerwood Road, suite 200
San Ramon, CA 94583
(888) EnerSure

BEST AVAILABLE COPY



Justin Boyce
Direct Tel: (650) 813-4853
Direct Fax: (650) 813-4848
justin.boyce@dechert.com

May 19, 2005

FEDERAL EXPRESS AND FACSIMILE

Robert Hunter
TRENDPOINT SYSTEMS, INC.
111 Deerwood Road, Suite 200
San Ramon, CA 94583

**CONFIDENTIAL: ATTORNEY-CLIENT
AND WORK PRIVILEGED**

Re: Transfer of Patent Files, and
U.S. Patent Application Serial No. 10/683,928
Filed: July 8, 2003
Entitled: **METHOD AND APPARATUS FOR READING AND CONTROLLING
UTILITY CONSUMPTION**
Our Ref: 375283-00103 (352732)

Dear Mr. Hunter:

We have received your facsimile dated May 18, 2005, in which you confirm your decision to terminate use of Dechert LLP as counsel for Trendpoint and you, and your request that we transfer all the files to you. The original of this letter, along with the attachments and all the original files, is being sent to you by overnight delivery, using Federal Express. One of the attachments to this letter lists all of the files being delivered to you. (We have retained a copy of the original files for our records, at no expense to you).

A copy of this letter and all attachments (excluding the original files), is being faxed to you this date, in order to ensure the quickest receipt by you.

With this transfer, and except as indicated below (regarding notification to the U.S. Patent Office (USPTO)), henceforward we will take no further actions in your patent matters and will incur no further costs on your behalf.

In the voice message you left for me on May 13, 2005, wherein you indicated your intent to terminate Dechert's representation of Trendpoint and you on all patent prosecution matters, you cited several reasons for the decision to end this representation. You stated that the reasons included your views that: (1) we had a difference in philosophy regarding effective advocacy before the USPTO; (2) we

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were allegedly late in submitting a Response to an office action for application serial no. 10/683,928 (the "'928 application"); and that (3) the Response we filed for the '928 application allegedly did not comport with your instructions. While I appreciate your sharing your thoughts with us, I do want to indicate some of the reasons why I disagree with your assessment. Hopefully, my response will assist you in dealing with the next lawyer you hire to finish the prosecution which was originally started by a lawyer from whom you originally transferred the work to me.

In the first instance, it is worth noting that while we were discussing our patent prosecution strategy on the '928 application, you did not express a disagreement with our approach, nor did you speak of differences in philosophy regarding effective advocacy before the USPTO for this Response. Indeed, your first mention of this, or of any complaint, only came after the first significant bill for services rendered had been received by you.

With respect to the timeliness of filing the Response to the office action in connection with the '928 application in May 2005, as you know, it was done within the 3-months statutory period and without incurring any extension fees. In short, it was not filed late.

Finally, with respect to the contents of the Response, I believe that the contents were consistent with your instructions and in keeping with appropriate prosecution strategy. Before the filing, we discussed my advice about keeping the substance of the Response narrow and focused, to minimize the risk of creating undesirable prosecution file-wrapper estoppel which might affect enforcement of the patent which we hoped would issue on this application. Indeed, your express instructions authorized us to proceed as we did. On Saturday, March 12, 2005, I forwarded to you by e-mail the draft of our completed Response for your review. In that e-mail, I stated that "I believe that I have addressed all of the points we discussed."

We had lengthy discussions about the Response by telephone on Monday, March 14, 2005. During our conversation, we also discussed the possibility of the Examiner raising a double patenting rejection over your own issued '097 patent, since the limitation you instructed me to add to independent claims 1 and 8 in the draft Response was substantially similar to a limitation found in claims 11 and 25 of the '097 patent. You will remember that I performed some research for you on that issue, and called you back on the same day. During that later telephone conversation, we discussed certain case law holdings and M.P.E.P. authority pertinent to the doctrine of double patenting, and we concluded that: (1) the amended independent claims set forth in the March 12, 2005 draft response were patentably distinct from the issued claims of the '097 patent; and (2) because we

believed the amended claims were patentably distinct, and because the examiner has yet to raise any double patenting rejection, the appropriate measure was to wait and see if the Examiner raised a double patenting rejection, and respond later if needed.

On March 14, 2005, I forwarded to you by e-mail a final draft of the Response for your review (*i.e.*, the one we filed timely on the 3-month due date), and stating that “[u]nless you have more comments, we will file this [the attached amendment] ... after we’ve had a chance to prepare information disclosure statements.” On the same day, you responded to my e-mail attaching the final draft that it “sounds fine.” Note that the “remarks” section of the Response did not change between the March 12, 2005 draft and the final March 14, 2005 draft. Therefore, you reviewed the same exact “remarks” section twice, and you did not provide any comments or suggestions other than raising the possibility of a double patenting rejection, which we discussed and concluded it need not be addressed.

After receiving your March 14, 2005 e-mail indicating that the final draft “sounds fine,” we proceeded, as required by law, to review all of Trendpoint’s patent files (received from the Law Office Of Derek Westberg) to determine whether we needed to submit any information disclosure statement (“IDS”) on the ‘928 application. Following this procedure, we did in fact file an IDS for the ‘928 application as well as for several other Trendpoint patent applications. It was for Trendpoint’s benefit that this action was taken before filing the Response. From March 14, 2005 to the time we filed the Response in May, you did not send us any further comments or suggestions regarding the Response (*i.e.*, beyond your final approving comment, “sounds fine”), nor did you suggest that our Response did not comport with your instructions in connection with the ‘928 application. Our records are very clear on these points, as they also indicate that your recent comments and criticisms were only made after you had received your first significant bill from us, reflecting the work we had done and requesting payment therefore.

I understand that during telephone conversations this week you expressed displeasure with the “Remarks” section of the Response on the ‘928, to the effect that it was too short and unpersuasive. I find these comments difficult to understand in light of the foregoing and in light of your earlier express approval of the final draft. Nevertheless, I want to make sure you know that there is a procedure by which an applicant may seek to supplement the Response at this time. This is available under Patent Rule 1.111(a)(2), which essentially provides that you may be allowed to file a supplemental reply to the current office action unless the USPTO Director disapproves, for example if the supplemental reply unduly interferes with an office action being prepared in response to the previous reply. (*See* 37 C.F.R. 1.111, available on-line at the P.T.O. website.). If you want to do so, time is of the essence. The cited rule indicates that the likelihood of permitted supplement

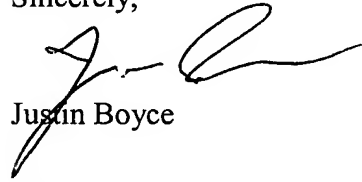
Mr. Robert Hunter
May 19, 2005
Page 4

decreases as time passes. Since you have indicated that you are either going to retain new counsel or represent yourself, we want to make sure you are aware of the time-sensitivity with respect to your recently expressed desire to have a lengthier "remarks" section.

Finally, in your letter you requested that we send you the forms necessary to transfer the cases within the PTO. In order to avoid confusion, and to comply with our professional responsibilities both to the client and the USPTO, we have filed with the USPTO withdrawal documents, and have notified the relevant parties of your correspondence address. See copies attached. We also advise you that you should review all of Trendpoint's files for any upcoming due dates, deadlines or any other action that should be taken. You should also be aware that an office action was mailed in U.S. Application Serial No.10/615,572, on April 6, 2005. You should consider whether any references cited in the office action should be submitted in an Information Disclosure Statement in any other application.

We regret that, despite our good efforts and competent representation, you claim to be dissatisfied with our services and unwilling to pay the bill which you received shortly before communicating your complaints.

Sincerely,



Justin Boyce

JB/cas

Enclosures